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Applicant(s): James V. Albanese et al.

Docket No.

ULB-002

Serial No.

09/656,769

Filing Date

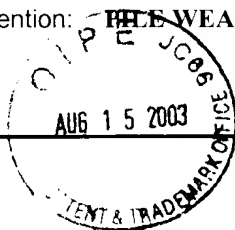
09/07/2000

Examiner

Jennifer A. Boyd

Group Art Unit

1771

Invention: ~~FILE~~ WEATHERSTRIPPINGI hereby certify that this **RESPONSE TO OFFICE ACTION OF APRIL 18, 2003**

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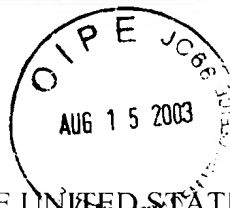
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicants: James V. Albanese et al.

Serial No.: 09/656,769

Filed: 09/07/2000

For: PILE WEATHERSTRIPPING

Examiner: Jennifer A. Boyd

Art Unit: 1771

Atty. Docket: ULB-002

RESPONSE TO OFFICE ACTION OF APRIL 18, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The following responds to the points raised by the Examiner in the April 18, 2003 Action. Each of the rejections will be more specifically argued hereafter.

The Examiner renewed the objection to the form of the claims where Applicants define the flat weather strip structurally and functionally. Namely, as a flat pile which upon installation into a slot, overcomes the tendency of the pile to lie flat, and creates an upstanding pile of controllable bendability. It is believed that defining a product by what it is and what it does (functionally) is not indefinite under Section 112 (See In re Fuetterer, 138 USPQ 217 (CCPA 1963), In re Swinehart et al., 169 USPQ 226 (CCPA 1971); and In re Hallman, 210 USPQ 609 (CCPA 1981). Moreover, it is well accepted to define inventions by their composition (here the flat pile) and their utility. Accordingly, the claims are clear and not indefinite as contended by the Examiner.

The new references Hoag, U.S. Patent No. 2,989,766 and Zuiddam, U.S. Patent No. 4,866,808 relate to a brush and to a rug. These are not pile weatherstripping as claimed, and is submitted to be non-analogous art. What the action alleges (erroneously as argued below) corresponds to what applicant claim is mere happenstance, and such accidental showings have been held not to constitute anticipation under the law, since the references do not function for the same purpose as the claimed inventors. (In re Meng and Driessen, 181 USPQ 94, 97 (CCPA 1974) and In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988).

The rejection essentially presents only one issue, namely whether anything in the principal references, Johnson, U.S. Patent No. 5,817,390, and the Hoag and Zuiddam references show the use of a flat pile which tends to lie flat in weatherstripping. There is nothing in Hoag or Zuiddam that their bristles constitute a pile that tends to lie flat. In fact, Hoag's bristles (6) must be folded about a wire (4) before they can be clamped by the channel (1). Once folded, the bristles (6) tend to stay upright and not to bend sidewise as would be the case for a flat pile.

Similarly, bristles (20) of Zuiddam must be wrapped about a wire (26) just like the bristles in Hoag. Since bristles in both Hoag and Zuiddam have to be in upright position in order to be inserted in their channels, it would be impossible to make the brush or rug with these bristles as described in these references if they had a tendency to return to a flat condition.

The two new references, Hoag and Zuiddam, are really the same as the Johnson patent in so far as they use threads, which have sufficient stiffness to stay upright. In Johnson, the stiffness is provided by winding the yarn on a mandrel and then welding the bent end to the bottom of the channel in the backing strip. In the other references, the yarn or wires used for the brush are sufficiently stiff that they stand up when enough of their length is held inside a slot. In no case for any of these references is the yarn in a pile, which has the tendency to lie flat, and retains that tendency after being put into the T-slot in the frame member. The starting material of the present invention is a flat pile, not merely yarn or wires, which are stiff enough to stand up when, put into a slot or looped in a mat as in a rug.

Applicants have presented and filed exhibits as to the nature of the pile described in the Johnson patent, and how the yarn is used in Johnson to make an upstanding pile. The record includes a Declaration of one of the inventors. These, by this reference are incorporated herein, and form a part of this Response. The exhibits show that the Johnson pile does not exist until it is made to stand up. The new references on the brush and rug are merely cumulative of the Johnston type of upstanding yarn structure. Accordingly, there is more than sufficient evidence to show that the claims in this case are not anticipated by Johnson, Hoag or Zuiddam because they do not use a flat pile as the starting material to make pile weatherstripping. These references simply do not show weatherstripping, made of flat pile as claimed.

Accordingly, there can be no anticipation or suggestion of the flat pile weatherstripping claimed in their application based upon references that do not disclose and cannot be operative, if they are made with a flat pile (a pile which tends to lie flat). The Examiner should find, and she so found in the examination of the claims in the corresponding PCT Application, that the claims have inventive merit and are patentable.

The following is directed to the specific items of the Action:

In items 2 and 3 of the Action, the claims are rejected under 35 USC 112(2). It is respectively submitted that the form of the claims is proper in that 35 USC 112(2) requires only that the language of the claim is sufficiently clear so that the scope of the claim is discernable. Ex parte Wu, 10 USPQ2d, 2031 (PTBAI 1989). In other words, that the claim would be understood by one skilled in the art, see In re Marosi et al., 218 USPQ 289, 292 (Fed. Cir. 1983); Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc. 221 USPQ 568, 574 (Fed. Cir. 1984) and Ex parte Hradcovsky et al., 214 USPQ 554 (PTBA 1982).

The phrasing referred to in paragraph 3 of the Action refers to the utility and functionality of the invention which does not render the claims indefinite where as here the claims are understandable and made even more understandable by such language. The Examiner will note that the slot is set forth in the preamble in Claim 1 *et seq.* which is a proper practice in patent claim drafting. See Stradar et al. v. Watson (113 USPQ 365-368 (D.C. Cir. 1957), and Bell Comm. Res. Inc. v. Vitalink Comm. Corp., 34 USPQ2d 1816 (Fed. Cir. 1995).

Accordingly the 35 USC 112(2) rejection should be withdrawn.

In Item 5 of the rejection, Claims 22-25, 27-28, 30-33 and 42 were rejected as anticipated by Hoag. The clamping of the bristles is merely to keep them from falling out and does not imply, let alone suggest, that the bristles have a tendency to lie flat. If the bristles had a tendency to lie flat, they would defeat the purpose asserted therefore by Hoag which is as a brush. The base of the brush in Hoag merely encapsulates the clamped bristles and is not a slot. See Hoag column 3, line 42 *et seq.*, and column 4, line 10 *et seq.* As to Claims 23 and 30, the wire 30 is not attached to the bristles, but is merely a form about which the bristles are strung. There is no adhering relationship of the wire and the bristles as is the case in the invention claimed in Claims 23 and 30.

As to Claims 24 and 31, the clamp is not a locking fin and is not designed to engage the walls of a slot. The bristle assembly with the clamp in Hoag is merely an encapsulated structure.

As to Claim 27, the brush or mat of Hoag is not designed to provide a seal but merely to brush off soil caught in a golfer's cleats. To do this the brush tends to stay upright. The brush would not serve its intended purpose in Hoag, if it operated as parts which were biased away from each other as they tend to lie flat. The Examiner's interpretation of Hoag, with all due respect, is erroneous since it flies in the face of what is described therein and is inconsistent with the Hoag specification. See Ex parte Research and Manufacturing Co., Inc., 10 USPQ2d, 1657 (PTBAI 1989), and In re Bond, 15 USPQ2d, 1566 (Fed. Cir. 1990).

As to Claim 28, Hoag does not have a slot. In Hoag the angle in which the clamp and bristles are located defines the shape of the molded structure in which this assembly is embedded. In short, the slot structure is merely a draftsman's simplification of the embedded structure and does not anticipate.

As to Claim 32, the Hoag clamp 3 is not a locking fin but merely a clamp. The bristle assembly is retained in the base merely because it is embedded therein as described in the specification. It is mere speculation to say that the Hoag brush functions in two parts. As shown and described it functions as a single brush element and does not have the functionality of Applicants' flat pile.

As to Claim 42, the concept of using a bead to provide separable parts of a flat pile is completely absent in Hoag.

In item 6 of the rejection, Claims 22, 23, 27, 28 and 30 were rejected on Zuiddam. It is respectfully submitted that the Zuiddam floor mat is different in kind from a pile weatherstrip. The difference does not constitute a different use of the same structure, but an entirely different article of manufacture. Accordingly the Examiner's reliance on Ex parte Mashan is respectfully submitted to be misplaced. There is absolutely no basis for the Examiner's speculative finding that the wires of Zuiddam tend to lay flat. It is beyond speculation that wires have stiffness and retain shape after being bent beyond their elastic limit. This is clearly consistent with the purpose of a floor mat in the Zuiddam reference and totally inconsistent with what is claimed by the Applicants.

As to Claims 23 and 30, there is no adherence or adhering relationship of the wires.

As to Claim 27, there is no sealing at all in Zuiddam. What Zuiddam wants to do is brush off dirt adhering to the sole of a shoe. The wires move with the so-called profiles 12 to enhance the scraping action (paragraph starting on line 20 of column 3 Zuiddam). There is absolutely no conceivable sealing action in Zuiddam.

As to Claim 28, the Zuiddam wires are merely embedded in the rubber like profiles which have a cross action smaller than the bent ends of the wires. There is no slot, let alone an angularly angled slot profile as in Claim 28.

As to the combination of Hoag with Johnson in item 12 of the Action, there is absolutely no basis for the combination since Johnson is weatherseal and Hoag is for a mat or brush. The combination appears to be suggested by Applicants' disclosure and by nothing in the references as required by patent jurisprudence. See In re Vaeck, 20 USPQ2d 1438, 1442 (Fed. Cir. 1999). Accordingly, this rejection should be withdrawn.

As to the other rejection based on the Johnson U.S. Patent No. 5,817,390 ('390), and the combination of the Johnson U.S. Patent No. 3,404,487 ('487), with the Italian patent and the German patent, these rejections are based on the assumption that the Johnson '390 patent is "directed to a pile weatherstrip with a plurality of strands divided in separate parts intentioned to spring outwardly." There is nothing in the Johnson '390 patent to support this contention.

The Johnson '390 patent incorporates U.S. Patent No. 4,302,494 (Horton), which described the basic mandrel formed weatherstripping and points out that because of the flanges in the backing strips, the yarn is not flat but is upright (see paragraph starting on line 37 of column 4 of the Horton patent).

This upright pile is certainly not flat in the case of the Johnson '390 patent. Because of the tendency of the sides of the pile to be upright rather than flat, it is necessary to use wires to raise the strands so as to enable them to be cut into two piles and removed from the mandrel. This is clearly set forth in the paragraph starting on line 44 of column 4 of the Johnson '390 patent. As far as the Johnson '487 patent is concerned, the Examiner will note that the piles are made to stand upright and not lie flat. This is expressly stated in the Johnson '487 patent, in column 2, at lines 61 and 62. A flat pile is simply not obvious from that described in these two patents. The claims and the

specification of this application clearly define a flat pile where the strands are flat as they extend longitudinally. The tension and resilience of the claimed strands is set forth as providing for the flat pile. Any interpretation of these patents as constituting a flat pile, or of the claims as including within their scope a pile which is maintained upright, is inconsistent and flies in the face of the specifications of these patents and the present application, and is improper under the law, as cited above, and in fact.

It goes without saying that the Johnson '390 weatherstrip is designed to go into a slot. However, the slot does not affect the pile of the weatherstrip. The construction asserted by the Examiner is contrary as to what is in the specification and is impermissible under the decisions concerning construction of a reference cited above. It is respectfully submitted to be unnecessary to combine the two Johnson '390 and '487 patents since the '487 patent does not add anything which is not already disclosed in '390 patent with respect to the use of a T-slot to hold a weatherstrip.

There is clearly no locking mechanism by any fin which engages a slot let alone a lip of a slot as claimed in some of the rejected claims. The rejection of Claim 4 in item 9 of the Action is respectfully traversed in that the use of a foam seal at a corner does not suggest how a flat pile weatherstripping as claimed could be utilized at the corner of a frame. Accordingly this rejection should be withdrawn.

The rejection at item 10 of the Action on the combination of a foam seal in a capturing slot again does not add anything to how a kerf would hold a pile weatherstrip let alone one with a locking fin on the outside. Accordingly this combination does not suggest the invention of Claim 15 and 16.

The rejection of Claim 3 in item 11 of the Action in view of the Johnson '390 and '487 patents and Dieterich '038 is respectfully traversed in that the backing strip, not the pile, does the locking in Dieterich. Nothing in these patents remotely suggests that the pile could provide locking action or that a normally flat fin on a flat pile can facilitate locking.

As to the rejection in item 13 of the Action on Hoag in view of the German patent '242, there is absolutely no motivation for the combination of stiff brush and a soft foam seal except as might be suggested by Applicants' disclosure. Such combination rejections are not consistent with accepted patent jurisprudence. The foregoing

arguments with respect to Hoag are also applicable and urge the withdrawal of this rejection.

In item 15 of the Action, Claims 40 and 41 were rejected on Hoag in view of the Italian patent.

As argued above Hoag does not have a locking fin. The teaching in Hoag of encapsulation provides no impetus to the use of a kerf to engage a soft foam strip as in the Italian patent. The arguments expressed above with respect to Hoag also necessitate the withdrawal of this rejection. Moreover, the combination of a brush mat with a weatherseal is suggested solely by Applicants' disclosure and not by anything in the references. Such combination rejections are not permitted under controlling patent jurisprudence.

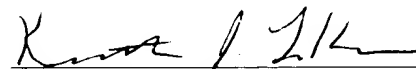
The Examiner repeats essentially similar rejections to those set forth above with respect to other claims in paragraph 17 and 18 of the Action. Again, it is respectfully urged that the principal references do not suggest what was claimed as argued above and the combination with the secondary references appears to be suggested only by Applicants' disclosure since the principal and secondary references are for dissimilar purposes and their combination would not be suggested to one skilled in the art.

The allowability of claims in paragraph 19 and 20 of the action is gratefully acknowledged.

Favorable action upon further consideration and allowance of this application is believed to be in order and is respectfully solicited. A petition is enclosed for a one-month extension of time.

Respectfully submitted,

Dated: August 13, 2003



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Enclosures: Certificate of Mailing by First Class Mail; and
Petition for one-month extension of time.